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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,380	12/28/2000	Denny Ho	101229-00000	5574

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/14/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary

Application No.

09/749,380

Applicant(s)

HO, DENNY

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 02L 12-11-04 20 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 16 August 2004 have been fully considered but they are not persuasive. The arguments are addressed at para. 5-7 below. In addition, the examiner has found a limitation that might permit the application to be allowed (para. 8-10 below).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al.
4. Scroggie et al. teaches a system, server, apparatus, method and record medium for controlling sales promotions using direct mail based on an Internet technology, the method comprising: Transmitting by e-mail to a registered customer a plurality of inventive offers, to which the customer must reply in order to obtain the incentives, or sending to the customer an incentive or a token which must be printed by the customer and bears a customer identification col. 12 lines 44-65 and col. 2 lines 54-65), either of which reads on obtaining a determined result as to whether or not issued direct mail was browsed; and tracking the purchase history of customers using the incentives (col. 4 lines 39-47), which reads on automatically controlling sales promotion activities for commodities advertised by the direct mail based on the determined result.
5. Applicant argues (p. 9) that "a determined result as to whether or not issued direct mail was browsed" should be interpreted as determining, without action on the part of the recipient, whether or not the direct mail was browsed or opened. In other words, applicant argues that the "determining" is necessarily done by the "direct mail open acknowledge request option" disclosed at para. [0015], second line, of the published specification (US 20010037237A1).

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6. However, the disclosure does not qualify as the "clear definition" required by MPEP § 2111.01: The specification does not establish the metes and bounds of the term "a determined result as to whether or not issued direct mail was browsed/opened".¹ A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". In the instant case, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any determination as to whether or not issued direct mail was browsed/opened. The determination taught by Scroggie et al., which requires an explicit customer reply, reads on that.
7. Applicant also argues (p. 9) that "automatically" controlling promotion activities means "without any further action by the recipient", but Scroggie et al. clearly teaches that after receipt of the customer reply.

Suggestion of Allowable Subject Matter

8. Scroggie et al. does not teach or suggest use of a "direct mail open acknowledge request option" (para. [0015], second line, of the published specification, US 20010037237A1). Hence adding this limitation to the claims, in place of "obtaining a determined result", would overcome the instant rejection.
9. Furthermore, the examiner has performed a preliminary search for prior art teaching a direct mail/email open acknowledge request option. The closest prior art found was Nielsen (US006108688A). Because Nielsen does not teach or suggest the application of a direct mail/email open acknowledge request option to marketing or sales promotion, the examiner judges that combination of Nielsen and Scroggie et al. would not be obvious.
10. Applicant is cautioned that an allowance could not be considered until this or any other amendment was thoroughly searched.

¹ The disclosure says that the determination is whether or not the message was "opened" or "browsed". For example, compare para. [0008] and [0010]. Hence the two terms are taken to be synonyms here. Para. [0015] also equates "direct mail" with "electronic mail".

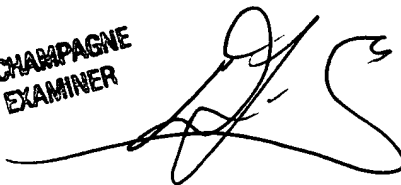
Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.
15. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

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16. Applicant may have after final arguments considered and amendments, including that suggested by para. 8 above, entered by filing an RCE.
17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Unit 3622 (2121 Detail)

11 December 2004